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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,138	09/23/2003	Indukumar G. Shah	MCP-5013	7577
27777 7590 04/30/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER QAZI, SABIHA NAIM	
			ART UNIT 1612	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/671,138

Applicant(s)

SHAH ET AL.

Examiner

Sabiha Qazi

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Non-Final Office Action

Claims 1-13 are pending. No claim is allowed. Amendments are entered.

Summary of this Office Action dated, 2008

1. Continued Examination Under 37 CFR 1.114
2. 35 USC § 103(a) Obviousness Rejection
3. Response to Remarks
4. Communication

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be *obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negatived by the manner in which the invention was made.*

This application currently names joint inventors. In considering patent ability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as obvious over SUNSHINE (US Patent 4,486,436), TENCZA et al. (US Patent 4,943,565).

Applicant Claims

Applicant claim (1) a solid pharmaceutical dosage form comprising caffeine, a disintegrant selected from the group consisting of sodium starch glycolate, crosslinked carboxymethylcellulose, and mixtures thereof, and a cephalagic, wherein said caffeine is in the form of uncoated particles having an average particle size of about 70 to 600 microns, (2) the dosage form of claim 1, wherein the cephalagic is selected from analgesics, non-steroidal anti-inflammatory drugs, decongestants, and antihistamines and (3) the dosage form of claim 1, wherein the cephalagic is selected from the group consisting of acetaminophen, ibuprofen, ketoprofen, chlorpheniramine, diphenhydramine, and doxycyclamine.

Determining the scope and contents of the prior art (MPEP 2141.01)

SUNSHINE (US Patent 4,486,436) teaches analgesic and anti-inflammatory compositions comprising caffeine (3,7-dihydro-1,3,7-trimethyl-1H-purine-2,6-dione) and novel analgesic and anti-inflammatory compositions for use in eliciting an analgesic or anti-inflammatory response, said compositions comprising caffeine together with a selected non-narcotic analgesic/nonsteroidal anti-inflammatory drug or a selected narcotic analgesic, or both. When used in combination with the selected drugs, **caffeine enhances** the analgesic or anti-inflammatory response and also hastens its onset. (see the abstract). The reference teaches a composition of selected non-narcotic analgesics/nonsteroidal anti-inflammatory drugs, which differ substantially in chemical structure from aspirin, phenacetin and acetaminophen, and which have significantly different biological profiles therefrom, can be advantageously formulated into novel pharmaceutical compositions together with caffeine and administered to mammals, especially humans, to not only elicit a more potent analgesic or anti-inflammatory response but also to evoke such response more rapidly than possible by administration of the analgesic or anti-inflammatory agent alone. See lines 44-55 in column 6. Suitable disintegrators can include, without limitation, starch, methylcellulose, agar, bentonite, cellulose, wood products, alginic acid, guar gum, citris pulp, carboxymethylcellulose and sodium lauryl sulfate. See lines 34-60 in column 21. See the entire document especially lines 1-36 in column 5, lines 24-32 in column 6, examples and claims.

TENCZA et al. teaches tablets containing, in combination, aspirin, acetaminophen and caffeine having improved dissolution rates. The combination of aspirin, acetaminophen

and caffeine is popular in analgesic preparations and finds widespread use, particularly in over-the-counter (O.T.C) products. Moreover, a widely used dosage form for delivering this combination drug is tablet. Since these products are also likely to be subjected to elevated temperatures while in storage in warehouses and in homes, it has become customary in course of manufacturing such tablets to store them at elevated temperatures for extended periods of time to test their stability and the in-vitro availability of the active ingredients; i.e., **aspirin, acetaminophen and caffeine** for pharmaceutical action. One method for measuring the latter has been to measure the dissolution rates of the tablets. If the tablets meet a certain standard for dissolution rate, the active ingredients should be available for absorption into the blood stream within an acceptable period of time after ingestion.

The dissolution rates of tablets containing aspirin, acetaminophen and caffeine can be improved by incorporating a **low-substituted hydroxypropylcellulose** in sufficient amount to serve as a secondary disintegrant. See the entire document especially abstract, lines 5-40 in column 3, examples and claims.

Ascertaining the differences between the prior art and the claims at issue (MPEP 2141.012)

Presently claimed invention differs in claiming specific disintegrants.

Finding of Prima Facie Obviousness, Rational and Motivation obviousness or nonobviousness (MPEP 2142-2143)

It would have been obvious to one skilled in the art at the time the invention was made to prepare additional beneficial solid pharmaceutical compositions having good dissolution rate and synergism containing active and useful drugs in combination with caffeine and a disintegrant because prior art teaches that by the addition of caffeine synergistic results are obtained and second disintegrant is added to improve the dissolution rate. Motivation has been provided by both the references cited above because disintegrant carboxymethylcellulose is taught by SUNSHINE.

No criticality and/or unexpected results are noted.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

2. Claim 1-7 is rejected under 35 U.S.C. 103(a) as being unpatentable over TENCZA et al. (CA 1,336,687). TENCZA et al. teach caffeine and acetaminophen tablet compositions which embraces Applicants claimed invention. See the entire document especially abstract, example 1, page 9, 11, 15, 21 and 23. The caffeine is uncoated and granular with a particle size between 20 mesh to 100 mesh (pages 11 and 23). It is noted that a mesh size of No. 20 is equivalent to 841 microns and a mesh size of No. 100 is equivalent to 149 microns. The caffeine and acetaminophen tablet also comprises a disintegrant, such as crospovidone XL-20 (see page 9; and page 15, example 1). It is noted that crospovidone is well known in the pharmaceutical arts as crosslinked polyvinylpyrrolidone. The tablet is made via compression (page 23). The

acetaminophen is granular (page 23).

TENCZA et al. teach 80% of the caffeine in their caffeine composition tablet dissolves within 5 minutes using a USP paddle apparatus rotated at 50 rpm (figure 1 and pages 20-21). It is noted that Tencza et al. have adapted a dissolution rate such that at least 75% of the caffeine-acetaminophen tablet dissolves in under 45 minutes (page 21).

It would be obvious that at least 95% of the caffeine in the caffeine composition tablet of TENCZA et al. would be dissolved within 5 minutes since the reference teaches that at least 75% of the caffeine-acetaminophen tablet dissolves in under 45 minutes.

It would have been obvious to one skilled in the art to prepare a solid dosage compositions containing caffeine, drug and disintegrant with good dissolution rate because prior art teaches such dosages.

No criticality and/or unexpected results are noted.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Response to Arguments

Rejection under 102 (b) and 103 (a) is withdrawn. New rejections are being made.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day except Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sabiha Qazi/
Primary Examiner, Art Unit 1612

